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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Confirmation No. 4977
Peter HEROLD et al. : Attorney Docket No. 2006_0980A
Serial No. 10/587,150 : Group Art Unit 1625
Filed July 24, 2006 : Examiner John Mabry
AMINO ALCOHOL DERIVATIVES AND
THEIR ACTIVITY AS RENIN INHIBITORS : Mail Stop: Amendment

RESPONSE TO RESTRICTION REQUIREMENT
AND
REQUIREMENT FOR ELECTRON OF SPECIES

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEE FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975.

Sir:

This is responsive to the Office Action of March 21, 2008.

Initially, though the Office Action Summary page indicates that claims 1-7 and 10-13 are pending in the application, the pending claims are claims 1-13. These claims are set forth in the Preliminary Amendment filed with the application papers on July 24, 2006.

Substance of Interview

On April 7, 2008, Applicants' attorney contacted the Examiner by telephone, and noted that the definitions for the Group I and II subject matter in the Office Action does not reflect the claims, because the claims do not encompass compounds where X_1 is amino, as indicated in Groups I and II. Rather, the claims reflect that X_1 is carbonyl or methylene. After considering this matter, the Examiner informed Applicants' attorney that Groups I and II should define X_1 as methylene rather than amino.

Election

With this correction in place, Applicants hereby elect the subject matter of Group I.

The Examiner has also required a further election of a single disclosed species, in response to which Applicants elect the compound of Example 1 on page 21 of the specification. All of claims 1-13 read on the elected species.

These elections are made with traverse.

Traversal is based on the fact that, contrary to the opinion of the Examiner, the instant claims do not encompass compounds of formula I of EP 0519433. In formula I of this reference, the COH-group and the NH-group are separated by just one carbon atom (the CHR⁴-group), whereas the instant formula (I) shows four carbon atoms, including the group X₁ which can be carbonyl or methylene. It is improper to base a restriction requirement on this erroneous interpretation of the chemical formulae. Applicants thus respectfully submit that **the special technical features of the present invention and the EP '433 reference are different from each other.**

For these reasons, Applicants take the position that the requirement for restriction and election of species is improper and should be withdrawn.

Applicants note that the foregoing elections are made while reserving their rights under 35 U.S.C. §121 to file a divisional application for the non-elected subject matter, although as indicated above, Applicants have traversed the restriction requirement and requirement for election of species.

Action on the merits is requested.

Respectfully submitted,

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April 21, 2008